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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,296	04/12/2001	Kenji Sano	16869P020100	4756

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EXAMINER
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HUYNH, SON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/835,296

Applicant(s)

SANO ET AL.

Examiner

Son P. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2001 and 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 7-18 and 25-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/6/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, 19-24, drawn to system for receiving EPG and converting it to a markup language, classified in class 725, subclass 39.
  - II. Claims 7-18, 25-38, drawn to method for remotely controlling a VCR using a remote handheld device, classified in class 725, subclass 58.
  - III. Claims 39-42, drawn to a recording device, classified in class 386, subclass 83.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as remotely controlling a video recorder can be used in other area such as remotely control recording system or parental control. See MPEP § 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown

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to be separately usable. In the instant case, invention II has separate utility such as recording device can be used in other area such as VCR system. See MPEP § 806.05(d).

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with attorney Chun- Pok Leung (650-326-2400 X5437) on June 3<sup>rd</sup> 2005, a provisional election was made with traverse to prosecute the invention of group I, claims 1-6,19-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-18 and 25-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6 and 19-20, 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US 2005/0028208).

Regarding claim 1, Ellis discloses a program information distributing method comprising:

receiving program guide information and video program data from plurality of main facility (12) or television distribution facility (16) (figures 1, 2a, 2c, 6a; par. 0067-par. 0069; par. 0080; par. 0103) broadly reads on the claimed feature of “receiving digital broadcast information for a broadcast program, comprising Electronic Program Guide (EPG) information and program contents information from broadcast station of a plurality of broadcast stations;

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the user television equipment (22) processes the received program guide information and video program data (figures 3-4; par. 0070-0071, par. 0080-par. 0086) broadly reads on the claimed feature of “extracting from said digital broadcast information, EPG information;”

Ellis further discloses remote access link 19 connected between user television equipment (22) and remote program guide access device (24) for transmitting program guide information from the user television equipment (22) for displaying on the screen of program guide access device (24) – par. 0071. The remote access link (19) may include any transmission medium, for example, dial up telephone line, a computer network or Internet link, etc. (par. 0094). The program guide data transmitted over link 19 may include HTML formatted markup language documents (e.g., web pages)- par. 0103-par. 0104, par. 0150). Thus, the claimed feature of “converting said EPG information to a markup language format” is broadly met by processing the program guide information for providing as HTML formatted markup language documents to remote program guide access device (24).

Regarding claim 2, Ellis further discloses transmitting program guide information in HTML formatted markup language documents to remote program guide access device over remote access link 19 (par. 0103-0104,0150) reads on the claimed feature of “transmitting said EPG information in said markup language format to a remote handheld user device.”

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Regarding claim 3, Ellis further discloses the remote handheld user device is selected from a group consisting of a mobile telephone or a Personal Digital Assistant (PDA) – par. 0092.

Regarding claim 4, Ellis further discloses the EPG information comprises, common EPG information and detail EPG information, the common EPG information comprising guide information for channels of the plurality of broadcast stations (e.g. HBO, ADU, etc. – figure 7), and the detail EPG information comprising program information specific to the broadcast program (e.g. title, description, etc. – figure 7, par. 0067).

Regarding claim 5, Ellis further discloses the guide information comprises a channel, a program title, a program start time, and a program duration time (figure 7, par. 0067).

Regarding claim 6, Ellis further discloses the detailed EPG information comprises a program synopsis (e.g. rating – figure 11).

Regarding claim 19, the limitations of the system as claimed correspond to the limitations of the method as claimed in claims 1-2, and are analyzed as discussed with respect to the rejection of claims 1-2.

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Regarding claim 20, Ellis further discloses the mobile device (remote access device 24) includes a browser program to display the mark-up language information to a mobile device user (figure 24, par. 0176).

Regarding claim 22, Ellis further discloses the mobile device includes a PDA (par. 0092).

Regarding claim 23, Ellis further discloses the mark-up language information, comprises HTML information (par. 0104).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2005/0028208) as applied to claim 19 above.

Regarding claim 21, Ellis further discloses remote program guide access device (24) may be any suitable personal computer, portable computer, palm computer, handheld



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personal computer, display remote, touch screen remote, automobile PC, PDA, or any suitable computer based device (par. 0092) and the remote program guide access device comprises communication device (58) may be any device such as cellular modem, modem, etc. (par. 0093) and link (19) can be any suitable transmission medium, which may include, for example, telephone line, infrared link, RF link, Internet link, etc. (par. 0094). It is obvious to one of ordinary skill in the art at the time the invention was made that the mobile device includes a cell phone so that the user can access program guide information using cell phone thereby giving user more convenience.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2005/0028208) as applied to claim 19 above, and in view of Shen et al. (US 6,401,059).

11.

Regarding claim 24, Ellis teaches a device as discussed in the rejection of claim 19. However, Ellis does not specifically disclose the markup language information comprises XML information.

Shen discloses receiving program guide information, converting the received program guide information into XML markup language and providing the converted TV program information to PDA (figure 4A- fig. 4B; col. 2, lines 40-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

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Ellis to use the teaching as taught by Shen in order to identify the information and thereby directly store the information in the database (col. 2, lines 53-65).


### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P. Huynh whose telephone number is 571-272-7295. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SPH  
June 6, 2005



CHRIS GRANT  
PRIMARY EXAMINER